

**REMARKS**

Claims 33-50 are all the claims pending in the Application, claims 1-6, 11-17 and 24-28 having previously been canceled, and claims 7-10, 18-23, and 29-32 having been withdrawn from consideration.

Claims 46-50 have been rejected under 35 U.S.C §112, second paragraph, as being indefinite. The non-narrowing amendment to claim 46 submitted herewith is believed to be fully responsive to this rejection.

Claims 33, 39, and 46 have also been amended to correct obvious typographical and grammatical mistakes. Such amendments have not changed the scope of these claims. Applicant further submits that the various claim amendments presented herein raise no new issues requiring further consideration and/or search, and accordingly entry is believed proper, and is respectfully requested.

Claims 33-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vasnier (U.S. patent 6,504,932) in view of Japanese document JP-63168755. Claims 46-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vasnier, in view of JP-63168755, and further in view of Erola (U.S. patent 6,092,133). Claims 33-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarskog (WO 01/62029) in view of Vasnier. Claims 46-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarskog in view of Vasnier and Erola. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

**Substance of Interview**

First of all, Applicant gratefully acknowledges the courtesies extended by the Examiner in the 13 October 2005 telephone interview with Applicant's representative, Jeffrey Lotspeich. Pursuant to M.P.E.P. § 713.04, Applicant provides the following remarks. Independent claims 33, 39, and 46 were discussed with regard to Vasnier, Sarskog, and JP-63168755. The specifics of the arguments presented during the interview are set out in detail below.

**Rejection Under 35 U.S.C. §103(a)  
as being unpatentable over Vasnier and JP-63168755**

The Examiner rejects claims 33-45 under 35 U.S.C. §103(a) as being unpatentable over Vasnier in view of Japanese document JP-63168755.

**Vasnier lacks the required “displayer”**

Independent claims 33 and 39 are directed to a backup system that includes a “connector” that “transfers data of said first SIM card to said memory.” The claim further requires “a displayer coupled to said processor *for displaying said data*” (emphasis added).

As set out on pages 2 and 3 of the Action, the Examiner asserts that screen 28 and contact elements 211 of Vasnier teach the above-noted elements of claims 33 and 39. The Examiner specifically refers to col. 5, lines 36-40, of Vasnier as providing the requisite teaching of a displayer. Applicant respectfully disagrees with the Examiner's characterization of the teachings of this reference.

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As discussed during the interview, Applicant does not does not disagree with the Examiner's reasoning that Vasnier depicts screen 28, and that this screen is somehow configured to depict text. However, Applicant disagrees as to type of data that the Vasnier screen displays. The limited teaching of the cited portion of Vasnier (col. 5, lines 36-40) is reproduced below:

"In parallel with this a DISPLAY step 37 of a DISPLAY TEXT transfer commands the display on the screen of the mobile terminal of a text corresponding to the call operation in progress."

Simply put, Vasnier describes displaying "*text corresponding to the call operation in progress*" (emphasis added), whereas claim 33 recites a displayer for displaying "data of said first SIM card." Clearly, Vasnier and the invention of claims 33 and 39 are directed toward systems that display different and unrelated types of data.

Applicant submits that "*text corresponding to the call operation in progress*" refers to call status indicators such as "calling out," "waiting," and "data transferring." Applicant has extensively reviewed Vasnier and is unable to locate any disclosure, whatsoever, that teaches or suggests that data transferred from SIM card 10 is displayed on screen 28. In view of the forgoing, Vasnier cannot therefore teach or suggest "a displayer coupled to said processor *for displaying said data*," as recited in independent claims 33 and 39. Accordingly, and on this point alone, claims 33 and 39 are believed to be patentable over Vasnier, in view of Japanese document JP-63168755.

In the event the Examiner continues to maintain that Vasnier discloses the "displayer" feature of claims 33 and 39, Applicant respectfully requests the Examiner point out the specific portions of Vasnier, which, in the opinion of the Examiner, contain the alleged teaching, and explain how the cited portions need be interpreted in order to arrive at the Examiner's conclusions. It is

well settled in the law that when the Examiner asserts that there is an explicit or implicit teaching or suggestion in the prior art, the Examiner must indicate where exactly such teaching or suggestion appears in the reference. MPEP 707, citing 37 CFR § 1.104(c)(2); *See also In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

**Inherent teachings of JP-63168755 improper in a 35 U.S.C. 103(a) rejection**

Notwithstanding the above, Applicant respectfully points out another shortcoming of the cited references, with regard to independent claims 33 and 39. These claims further recite “an input means for inputting instructions to said processor, wherein said processor restores said data to a second SIM card according to said inputting instructions.”

On page 3 of the Action, the Examiner asserts that the “memory card backup system” of the Japanese document JP-63168755 (“JP ‘755”) teaches the just-identified element of claims 33 and 39. During the interview, Applicant explained that the sparse, three-sentence disclosure of JP ‘755 lacked any teaching or suggestion (inherent or explicit) relating to the restoring of data according to “inputting instructions.” The Examiner conceded that JP ‘755 did not explicitly provide such teachings, but indicated that these teachings were inherent in the reference.

The undersigned attorney explained that inherent teachings of a reference may not be used as a basis for a rejection under 35 U.S.C. 103(a). The Examiner was unaware of this legal principle, and requested that Applicant provide support for such a position. Applicant submits that with respect to obviousness rejections *per se*, such reliance on inherency is improper. *See In re Newell*, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) (Inherency and obviousness are entirely distinct concepts. The doctrine of inherency does not extend beyond anticipation.); see also *In re*

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*Spormann*, 53 CCPA 1375, 363 F.2d 444, 150 U.S.P.Q. 449 (1966); *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742 (1966); and *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (CCPA 1976).

The Examiner stated that JP '755 would be withdrawn, as to its inherent teachings, provided Applicant presents legal authority to support such a position. Applicant has complied with this request, and therefore requests that JP '755 be withdrawn as a valid reference in the current rejection of claims 33-45 under 35 U.S.C. §103(a).

Applicant submits that none of the references of record supply the above-stated deficiencies of Vasnier and JP '755. Therefore, Vasnier, whether combined with or modified by JP '755, does not teach or render obvious Applicant's invention as recited in independent claims 33 and 39. Thus, these independent claims, and their respective dependencies, claims 34-38 and 40-45, are believed to be patentable.

**Rejection Under 35 U.S.C. §103(a)**  
**as being unpatentable over Vasnier in view of JP-63168755 and Erola**

The Examiner rejects claims 46-50 under 35 U.S.C. §103(a) as being unpatentable over Vasnier, in view of Japanese document JP-63168755, and further in view of Erola.

Applicant submits that similar to claims 33 and 39 discussed above, independent claim 46 recites "a displayer coupled to said processor *for displaying said data*" (emphasis added).

Applicant has unambiguously demonstrated that Vasnier does not teach or suggest this just-noted claim feature. Moreover, the Examiner agreed during the interview that the current rejection using JP '755 would be withdrawn should Applicant present legal authority that supports the position that

inherent teachings of a reference may not be used as a basis for a rejection under 35 U.S.C. 103(a).

Applicant has complied with the Examiner's request, and therefore requests that JP '755 be withdrawn as a valid reference in the current rejection of claims 46-50 under 35 U.S.C. §103(a).

Applicant further submits that none of the other references of record in the present application supply the stated deficiencies of Vasnier and JP '755. For reasons similar to those set out above with regard to claims 33-45, Applicant submits that Vasnier, whether combined with or modified by JP '755, does not teach or render obvious Applicant's invention as recited in independent claim 46. Thus, this independent claim, and its dependencies, claims 47-50 are believed to be patentable.

**Rejection Under 35 U.S.C. §103(a)**  
**as being unpatentable over Sarskog and Vasnier**

The Examiner rejects claims 33-45 under 35 U.S.C. §103(a) as being unpatentable over Sarskog in view of Vasnier.

**Inherent teachings of Sarskog improper in a 35 U.S.C. 103(a) rejection**

On page 5 of the Action, the Examiner utilizes the Sarskog reference as inherently teaching several features of independent claim 33. Such features include: "a processor," an "input means," a "power supply," and a "displayer." Since inherent teachings of a reference may not be used as a basis for a rejection under 35 U.S.C. 103(a), as set out in detail above, Applicant respectfully requests that the rejection to claims 33-45 be withdrawn.

**Sarskog lacks the required “displayer”**

Again, independent claims 33 and 39 are directed to a backup system that includes a “connector” that “transfers data of said first SIM card to said memory.” The claim further requires “a displayer coupled to said processor *for displaying said data*” (emphasis added).

On pages 5 and 7 of the Action, the Examiner asserts that Sarskog discloses all of the features of claims 33 and 39, except for the “connector” feature for which the teachings of Vasnier are relied upon. The Examiner indicated that computers 4 and 6 of Sarskog teach (inherently) the “displayer” feature of claims 33 and 39.

Putting aside that this rejection relies upon an improper use of inherent teachings in a § 103(a) rejection, Applicant assumes for the sake of argument that computers 4 and 6 disclose a display. Even if this were true, such a display would not disclose the “displayer” feature of claims 33 and 39 because the Sarskog display does not display the required type of data. More specifically, Sarskog does not provide any disclosure, whatsoever, relating to displaying data of SIM card 2. Indeed, the Sarskog system emphasizes that computers 4 and 6 are used for safely storing information contained in SIM card 2, but lacks any teaching relating to the displaying of data of SIM card 2 on a display of computers 4 and 6 (See Sarskog Abstract, pg. 2 lines 1-6, line 21, and lines 25-29). Applicant is unable to locate any discussion in Sarskog as to what is displayed on the displays of computers 4 and 6 and, therefore, submits that Sarskog does not teach or suggest the “displayer” feature recited in claims 33 and 39.

For at least these two reasons, Applicant submits that Sarskog, whether combined with or modified by Vasnier, does not teach or render obvious Applicant’s invention as recited in claims 33

and 39. Thus, these independent claims, and their respective dependencies, claims 34-38 and 40-45 are believed to be patentable.

**Rejection Under 35 U.S.C. §103(a)**  
**as being unpatentable over Sarskog in view of Vasnier and Erola.**

The Examiner rejects claims 46-50 under 35 U.S.C. §103(a) as being unpatentable over Sarskog in view of Vasnier and Erola.

On page 7 of the Action, the Examiner has applied Sarskog and Vasnier to independent claim 46 in a manner similar to the rejection to claim 33. Similar to claim 33, independent claim 46 recites “a displayer coupled to said processor *for displaying said data*” (emphasis added).

Applicant has demonstrated that Sarskog does not teach or suggest this “displayer” feature.

Applicant has also demonstrated that inherent teachings of Sarskog may not be used as a basis for a rejection under 35 U.S.C. 103(a). Therefore, this current rejection to claims 46-50 is improper for reasons similar to those set forth above in the claim 33 rejection. Applicant further submits that none of the other references of record in the present application supply the stated deficiencies of Sarskog and Vasnier. Accordingly, Sarskog, whether combined with or modified by Vasnier or Erola, does not teach or render obvious Applicant’s invention as recited in independent claim 46. Thus, this independent claim, and its dependencies, claims 47-50 are believed to be patentable.

Applicant has reviewed the cited but not applied references identified on page 9 of the Action. They are interesting and appear to be generally related technology, but there is nothing of sufficient relevance to require detailed discussion.



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**CONCLUSION**

Applicant believes that the Examiner's rejections have been overcome and submits that the subject application is in condition for allowance. Should any issues remain unresolved, Examiner Vo is invited to telephone the undersigned attorney.

Respectfully submitted,

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